

23 MAY 2000



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Patent Cooperation Treaty  
Legal Office

Address: Assistant Commissioner for Patents  
Box PCT  
Washington, D.C. 20231

D. Bruce Prout  
CHRISTIE, PARKER and HALE  
P.O. Box 7068  
Pasadena, CA 91109-7068

In re Application of	:	
DANZIGER, et al.	:	
U.S. Application No. 09/403,472	:	DECISION ON PETITION
PCT No.: PCT/IL98/00204	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 29 April 1998	:	
Priority Date: 01 May 1997	:	
For: OPTICAL RESONATORS WITH	:	
DISCONTINUOUS PHASE ELEMENTS	:	

This is a decision on applicant's "PETITION FILED UNDER 37 CFR 1.47(a)" filed 08 February 2000 to accept the application without the signature of joint inventor, Yochay Danziger. The required petition fee of \$130.00 (37 CFR 1.17(i)) has been submitted.

**BACKGROUND**

On 29 April 1998, applicant filed international application PCT/IL98/00204 which claimed a priority date of 01 May 1997 and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 November 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 24 November 1998, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States at midnight on 01 November 1999.

On 22 October 1999, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the international application; a preliminary amendment; and an unexecuted declaration and power of attorney.

On 10 December 1999, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a one-month time limit in which to respond.

In order to satisfy the requirements of 35 U.S.C. 371(c)(4), applicants filed on 08 February 2000 the following papers:

- 1) a second transmittal letter;

- 2) a petition under 37 CFR 1.47(a) and required fee;
- 3) a declaration and power of attorney executed by joint inventors, Asher A. Friesem and Ram Orson on their own behalf and behalf of the non-signing joint inventor, Yochay Danziger;
- 4) a declaration claiming small entity status;
- 4) a declaration pursuant to PCT Rule 4.15; and
- 5) a petition and fee for a one-month extension of time.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) and (4) have been satisfied.

Concerning item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part, "before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application paper (specification, including claims, drawings, and oath and declaration) to the non-signing inventor for signature." A review of the present petition and the accompanying papers reveal that applicant has not satisfied the item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Yochay Danziger. Additionally, petitioner has provided a "Declaration Pursuant to PCT Rule 4.15" dated 28 September 1998 (Exhibit A), which is a statement, at best, that Yochay Danziger refused to sign the international application. No clear proof of the refusal of Mr. Danziger to execute the declaration and application papers for entry into the national stage in the United States has been provided.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Yochay Danziger and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

Regarding item (3) above, a clear statement of the last known address of the non-signing inventor must be provided. See M.P.E.P. 409.03(e).

### CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTH from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Extension of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



Richard Cole  
PCT Legal Examiner  
PCT Legal Office



Anthony Smith  
Petitions Attorney  
PCT Legal Office  
Tel: 703-308-6314  
Facsimile: 703-308-6459